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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ODLAND, DAVID E

ART UNIT PAPER NUMBER

2662

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DATE MAILED: 10/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/519,605

Applicant(s)

SUN, PETER C P

Examiner

David Odland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. The following is a response to the amendments filed on 08/05/2003.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 3 and 7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Referring to claims 3 and 7, the specification does not adequately disclose how the 'Token in Ethernet Protocol (TEP)' operates, in such a manner as to allow one of ordinary skill in the art to build and use the claimed invention.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1,2,4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Baratz et al. (USPN 5,742,596), hereafter referred to as Baratz.

Referring to claim 1, Baratz discloses a voice and data network (a voice and data network (see figure 1)), comprising:

a) a telephone and a computer connected to a voice and data module (VDM) (each host computer has a voice and data module with a computer and phone connected thereto (Note, the NIC and TCM cards of the host computer, as a whole, are being considered a voice and data module since the NIC is used for data communication by the host computer and the TCM is used by the telephone for voice communication and they also communicate between each other) (see items 42 and 43 of figure 1)),

b) a plurality of said VDM devices connected to a plurality of telephone wires in a building (a plurality of voice and data modules is connected through wires of a network (see figure 1)),

c) said plurality of telephone wires connected together to provide a telephone network (the connected wires comprise a network (see figure 1)),

d) a link to wide area network (LTW) connects said telephone network to a Public Service Telephone Network (PSTN) and an Internet Service Provider (ISP) (a telephony server connects the network to the PSTN and Internet (see figure 1)),

e) said LTW and said plurality of said VDM devices communicate together over said telephone network using communication addresses assigned to said LTW and each VDM of said plurality of VDM devices (the voice and data modules and the telephony server communicate using their assigned addresses (see figure 1 and column 6 lines 16-38)).

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Referring to claim 2, Baratz discloses the system discussed above. Furthermore, Baratz discloses that the plurality of said VDM devices connect a plurality of telephones and a plurality of personal computers (the voice and data modules connect a plurality of host computers and a plurality of telephones (see figure 1)) to a plurality of data signals and a plurality of voice signals on said telephone network operating concurrently (to a plurality of voice and data signals on the network (see figure 1)).

Referring to claim 4, Baratz discloses the system discussed above. Furthermore, Baratz discloses that telephone service is provided to said building from said ISP and said PSTN (the telephones are coupled such that they receive service from the PSTN and the Internet (see figure 1)).

Referring to claim 5, Baratz discloses the system discussed above. Furthermore, Baratz discloses that more than one LTW is connected to said telephone network (there are a plurality of voice and data modules connected to the network (see figure 1)).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6 and 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baratz.

Referring to claim 6, Baratz discloses a method for communicating between network elements in a voice and data network, comprising:

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a) monitoring a communication network by a first voice and data module (VDM) for a call from a second VDM and a call from a link to a wide area network (LTW) connected to said communication network (each voice and data module checks for incoming signals that may come from either other voice and data modules on the local Ethernet or from outside the local Ethernet by-way-of the telephony server (see figure 1 and columns 5 and 6)),

b) monitoring a first phone and a first computer attached to said first VDM for an outgoing call to a destination containing a second phone and a second computer connected to said second VDM (the voice and data modules inherently check for signals from the telephone and/or computer that are attached to it for any outgoing calls that may be destined for another voice and data module on the network (see figure 1 and columns 5 and 6)), or an outside phone and an outside computer network through said LTW (the voice and data modules also inherently check for any incoming calls it might receive from outside the local network by-way-of the telephony server (see figure 1 and columns 5 and 6)),

Baratz does not explicitly disclose the steps of connecting an outgoing call if the destination is not busy else providing a busy signal to the source and disconnecting the outgoing call, or connecting an incoming call only if the voice and data modules are not busy else sending back a busy signal and disconnecting the incoming call or disconnecting the calls when they are complete, all of which is specified in steps c-e. However, these steps are typically performed in conventional and ordinary communications systems where calls are set-up, torn down and busy signaling operations are performed, as in that of Baratz. Baratz discloses that calls are set-up through the use of typical DTMF tones and thus also torn down (see column 4 lines 46-48, column 5 lines 63-67 and column 9 lines 18-25). Furthermore, Baratz discloses that the system

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uses busy signals and checks the status of nodes that are trying to be contacted (see column 6 lines 39-47 and column 7 lines 56-59)). Lastly, Baratz also points out that the telephones of the system are ordinary sets that use DTMF signaling (see column 4 lines 46-48) and that the client related features of the system are the same as those typically found in conventional PBX equipment (see abstract). In light of the above disclosure and the fact that the call connecting, disconnecting and busy signaling procedures, as recited in the claim, are those typically performed, it would have been obvious to one skilled in the art at the time of the invention to include these steps in the system of Baratz.

Referring to claim 8, Baratz the system discussed above. Furthermore, Baratz discloses that communication between computers is done directly in Ethernet protocol eliminating the need for any conversion (the host computers on the network communicate using Ethernet packets (see figure 1 and columns 5 and 6)).

Referring to claim 9, Baratz the system discussed above. Furthermore, Baratz discloses connecting a long distance phone call is done through said ISP without the use of a computer to assist in the call (telephones can be directly coupled to the telephony server in order to make call over the PSTN and therefore no host computer is needed (see figure 1 and column 5)).

Referring to claim 10, Baratz discloses the system discussed above. Furthermore, Baratz discloses detecting a request from said first computer for a connection to an Internet service provider (ISP) (the voice and data module receives a request from a host computer to connect to the Internet (see figure 1 and column 6)), sending request for the connection to said LTW (the voice and data module receives the request from the host computer (see figure 1 and column 6)) and completing connection to said ISP is completed when the LTW responds with a connection

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completed signal (inherently the voice and data module lets the host computer know that it is connected to the Internet so that communication can take place (see figure 1 and column 6)).

Response to Arguments

8. Applicant's arguments filed 08/05/2003 have been fully considered but they are not persuasive.

On page 4 lines 4-8 of the response, the Applicant argues that the terms 'token(s) over Ethernet' (regarding claims 3 and 7) are enabled by the specification and relies on page 11 lines 19-22 of the specification and a definition of the term 'token' for this argument. The Examiner respectfully disagrees. This section of the specification merely states that the VDM and LTW use a Tokens in Ethernet Protocol (TEP), which allows each phone and computer to actively communicate at the same time. However, the specification does not adequately describe how such a protocol is implemented in such a manner to allow one of ordinary skill to make and use it. Specifically, it is not adequately described how the TEP operates or how it allows the computers and telephones to actively communicate at the same time. Furthermore, the definition of 'token' provided by the Applicant merely states that a token is used for controlling access to the medium of the network by the different stations of the network. This definition does not mention Ethernet or how tokens can be used with Ethernet to provide a TEP, therefore the specification is not enabling. Note, the Examiner concedes that Tokens and Ethernet are common protocols used *separately* in the art, however, how they are used to enforce a 'Token in Ethernet Protocol' is not adequately described.

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On page 4 lines 20-22 of the response, Applicants contend that the Baratz reference does not show telephone wires that form a telephone network, as recited in claim 1. The Examiner respectfully disagrees. As shown in figure 1, the telephones are clearly connected to the TCM cards using wires. Furthermore, the cabling that makes up the LAN 37 is used for transporting information to and from the telephones of the network. The applicant is reminded that the examiner is required to interpret the claim language in its broadest sense. In this case, since the LAN cabling is used for transporting telephone call information, the cabling can be considered 'telephone wires'. Lastly, the LAN cabling and the cables connecting the telephones to the TCM make up a telephone network since they transport telephone calls.

On page 5 line 29 through page 6 line 4, the Applicant argues that the rejection of claim 6 does not establish a prima facie case of obviousness because Baratz does not show monitoring a communication network *by* (emphasis added) a first VDM. The Examiner respectfully disagrees. The LAN 37 of Baratz (see figure 1) operates using the Ethernet protocol (see column 4 lines 29-34). In the Ethernet protocol, nodes of a LAN transmit packet in a broadcasting fashion, wherein packets from a transmitting node are sent to all other nodes on the LAN and the NIC of each node monitors (polls) the LAN for packets that are addressed to it and ignores packets that are not addressed to it. In this case, the NICs at each node of LAN 37 monitors the LAN for any packets that are broadcast having that particular NIC address as its destination address and accepts such packets. Therefore Baratz does anticipate this limitation of the claim and a prima facie case of obviousness has been properly made.

Conclusion

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9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Odland, who can be reached at (703) 305-3231 on Monday – Friday during the hours of 8am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou, can be reached at (703) 305-4744. The fax number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist, who can be reached at (703) 305-4750.

deo

October 6, 2003


HASSAN KIZOU
SUPERVISORY PATENT EXAMINER
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